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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/600,371	06/23/2003	Gholam A. Peyman	44770B	7058
29180	7590	02/08/2006		
BELL, BOYD, & LLOYD LLC P. O. BOX 1135 CHICAGO, IL 60690-1135			EXAMINER WILLSE, DAVID H	
			ART UNIT	PAPER NUMBER
			3738	
DATE MAILED: 02/08/2006				

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/600,371	PEYMAN, GHOLAM A.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Dave Willse	3738	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 28 April 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-35 is/are pending in the application.
- 4a) Of the above claim(s) 7,8,20,21 and 29-33 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-6,9-19,22-28,34 and 35 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)               | Paper No(s)/Mail Date. _____  |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>3-28-05; 5-16-05</u>  | 6) <input type="checkbox"/> Other: _____                                    |

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Claims 7, 8, 20, 21, and 29-33 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected species, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on April 28, 2005. Because of the crowded nature of the art (as seen by the references applied below, for example), the election of species is deemed to be warranted.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-6, 13-16, and 34 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Mitschischek, DE 195 01 444, which discloses a first lens 16 having a high minus portion (English translation: page 9, lines 14-16) adapted to supplement an existing artificial lens 15 so as to provide unmagnified and peripherally unrestricted vision (*ibidem*: page 9, line 22, through page 10, line 8). The lens system is *capable* of functioning with an external lens of sufficiently positive optical power so as to provide magnified and peripherally restricted vision,

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whether or not such was the intent. (The external lens is not a positively recited element of the present invention. Moreover, it has been held that the recitation that an element is “adapted to” perform a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense (*In re Hutchison*, 69 USPQ 138). MPEP 2106, section II. C., explains that language which suggests or makes optional but “does not limit a claim to a particular structure does not limit the scope of a claim or claim limitation”; “examples of language that may raise a question as to the limiting effect of the language in a claim” are “adapted to” and “adapted for” clauses.) Regarding claims 4-6, the haptic or haptics of the first lens 16 are *capable* of being, for example, glued to, sutured on, or threaded through the iris, whether or not such was the intent; attention is also directed to the above discussion on “adapted to” language. Regarding claim 34, the second lens 17 is *capable* of being at least partially inserted into the cornea, even though it was apparently not the intent to use both lenses 16 and 17 simultaneously.

Claims 1-6, 9-19, and 22-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Reynard, US 2003/0014107 A1. The first lens 20 having a high minus portion would have been obvious, if not inherent, for very myopic patients (paragraph 0001); such a lens portion is *capable* of being used with a sufficiently high positive diopter external lens so as to create magnified and peripherally restricted vision, for reasons cited above. Regarding claim 6, attention is directed to paragraph 0042 of the Reynard patent and to the above comments in reference to “adapted to” language. Regarding claim 10, a lesser minus outer portion would have been obvious in order to provide said myopic patients with intermediate and/or near vision (paragraphs 0017 and 0045). Regarding claims 9 and 11, plus and minus portions would have

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been obvious for myopic patients with presbyopia (paragraphs 0001 and 0003-0005). Regarding claim 12, a toric outer portion would have been obvious in order to help offset astigmatism (paragraphs 0001, 0017, and 0047). Regarding claims 17-19, securing an intraocular lens to an iris was well known in the art at the time of the present invention and would have been an obvious modification in order to help prevent trauma to the cornea and to ensure sufficient aqueous flow (paragraph 0042) by stabilizing the implant relative to the remaining iris portions.

Claims 1-6, 13-18, 26, 34, and 35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Donn et al., US 5,180,389. Figure 10 illustrates two negative lenses (column 8, lines 3-6; column 6, lines 16-18; column 7, lines 3-6; etc.) *capable* of being at least partially implanted in the eye and supplementing one another to function as a teledioptric lens system (column 3, lines 29-33; column 4, lines 49-52; etc.). The contact lens being at least partially implanted into the cornea would have been obvious in order to help rectify the problems identified at column 7, line 8, and column 8, lines 6-9. Regarding claims 17 and 18, affixing the intraocular lens to the iris would have been obvious from column 4, lines 60-65, and in order to stabilize the implant. Regarding claim 34, the “existing artificial lens” is not positively recited in present claim 1, and the Donn et al. intraocular lens is *capable* of functioning with an “existing” posterior chamber lens (column 4, lines 57-59), even though such was not the intent, so the aforementioned contact lens can be equated with the “second lens” of instant claim 34. Regarding claim 35, retaining a healthy natural crystalline lens and deploying the artificial intraocular lens anteriorly of said natural crystalline lens would have been obvious in order to maintain the natural accommodative function of the eye.

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Claims 1-6, 11, 13-16, 24, and 26-28 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Peyman et al., US 6,197,057 B1. Regarding claims 11, 24, 27, and 28, the supplemental intraocular lens **116** inherently possesses a slightly positive outer portion by virtue of the fact that the lens **116** takes on the curved form of the natural lens **106** (Figure 4; column 6, lines 26-29) or the intraocular lens **142** (Figure 18; column 8, lines 41-50) and thus contributes to the refractive convergence of parallel or nearly parallel light rays.

The Applicant's remarks have been considered but are deemed to be moot in view of the new grounds of rejection, which were necessitated by the added claims and by the addition and deletion of claim language (at claim 1, lines 3-6, for example). Therefore:

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dave Willse whose telephone number is 571-272-4762. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Corrine McDermott, can be reached on 571-272-4754. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.



Dave Willse  
Primary Examiner  
Art Unit 3738